

### **REMARKS**

Claims 18-30 and 39-58, as amended, are pending for consideration by the Examiner. Claim 18 has been amended to more clearly and distinctly recite that the wall teichoic acid (WTA) is of *S. aureus*, rather than related to *S. epidermidis* (*See, e.g.*, Specification at page 12, lines 16-17). Claims 26-27 and 29-30 have been amended to more clearly and distinctly recite the claimed invention.

Claims 39-58 are withdrawn from further consideration pursuant to 37 C.F.R. § 1.142(b), as being drawn to a nonelected Group I, there being no allowable generic or linking claim. Applicants respectfully submit that, since claim 38 had been cancelled, the Examiner was referring to the withdrawal of claims 39-58 from further consideration. The Office Action states that where claims directed to the product are elected, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined. Method claims 39-58 already meet these criteria and Applicant respectfully requests that they be rejoined as required once commensurate product claims are allowed. As no new matter has been added by the amendment herein, Applicant respectfully submits that the claims are in condition for allowance for the following reasons.

Claims 26-27 and 29-30 were objected to under 37 C.F.R. § 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. The Examiner stated that Applicant is required to cancel the claims, or amend the claims to place the claims in proper dependent form, or rewrite the claims in independent form. Claims 26-27 and 29-30 have been amended to more clearly and distinctly recite that therapeutically effective amount of antibodies, fragments, or a combination thereof, inhibits or prevents a staphylococcal infection. Applicants respectfully request reconsideration and withdrawal of the objection under 37 C.F.R. § 1.75(c) in view of the clarifying amendments herein.

Claims 18-30 were rejected under 35 U.S.C. § 102(b) as being anticipated by International Publication Number W098/57994 to Fischer *et al.* ("Fischer") as evidenced by U.S. Patent Application Publication 2003/0228322 to Schuman *et al.* ("Schuman"). The Office Action states that Fischer discloses compositions of antibodies that bind to WTA, wherein the antibodies bind to lipoteichoic acids (surface exposed; *see* page 9, paragraph 2, last sentence) that are teichoic acids in the wall of staphylococcal strains and species and that Fischer discloses alleviation or block of staphylococcal colonization (citing to page 21, paragraph 2 for the phrase "staphylococcal infection") and that the LTA antibodies of Fischer

inherently anticipates the claimed invention and would bind to the teichoic acid of at least *S. epidermidis* in view of the same glycerol phosphate backbone noted in Schuman. (See ¶ [0008]). While Fischer discloses antibodies that bind to lipoteichoic acid (LTA), it fails to identically disclose each and every feature recited in claims 18-30, expressly or even inherently. As noted in the Office Action, LTA has a glycerol phosphate structure.

In contrast, the present invention recites compositions comprising antibodies, fragments, or a combination thereof that specifically bind to WTA of *S. aureus*, i.e., wall teichoic acid, rather than the lipoteichoic acid (LTA) of Fischer. In contrast to LTA, the claimed WTA of *S. aureus* is a distinct and entirely different molecule with a different chemical structure. WTA has a ribitol phosphate structure (*see, e.g.*, paragraph [0034] of the instant application; *see also* Weidenmaier *et al.*, *Nature Medicine*, 2004). At least because of the structural differences between WTA and LTA, it is clear that WTA is not the same molecule disclosed by Fischer—nor would it be inherent or expected that the compounds would function in a similar manner at all based on their completely different chemistry. Thus, the disclosure by Fischer of LTA antibodies, which are both structurally and functionally distinct from the claimed compositions including WTA-specific antibodies, or fragments or combinations thereof, cannot anticipate the claimed WTA antibodies.

Schuman fails to provide the alleged evidence of inherency as to the phosphate backbone of the claimed WTA-related antibodies. Applicants understand that Schuman is simply being used to show that the LTA antibodies in Fischer were later known to inherently possess a glycerol phosphate backbone, because combination of Schuman with Fischer would otherwise be an obviousness rejection that would be improper under 35 U.S.C. § 102(b).<sup>1</sup> Schuman also fails to disclose that WTA includes a glycerol phosphate backbone. Because both references fail to disclose--or remotely suggest--WTA of *S. aureus*, it is clear that Fischer "as evidenced by" Schuman cannot inherently contain a disclosure of the claimed compositions.

As stated in *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993), "the mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency." Here, the failure of both cited references to teach even WTA of *S. aureus* cannot be sufficient to establish inherency based on a disclosure of LTA or WTA of *S. epidermidis*. Moreover, there is no basis in either cited reference that WTA of *S. aureus* has

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<sup>1</sup> *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984).

any particular structure, much less the same glycerol phosphate backbone as the LTA in Schuman. In fact, it does not. The fact that *S. epidermidis* teichoic acid and lipoteichoic acid have a glycerol phosphate backbone, as disclosed in Schuman, is simply not relevant to WTA of *S. aureus*, as presently recited. Thus, Applicants respectfully request reconsideration and withdrawal of the rejection under 35 U.S.C. § 102(b).

Applicant now believes all claims to be in condition for allowance. Should the Examiner not agree with this position, a telephone or personal interview is requested to resolve any remaining issues and expedite allowance of this application.

Respectfully submitted,

Dec. 2, 2005  
Date

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202-282-5904